

Remarks

The first Office Action mailed September 1, 2005 objected to the abstract, provided a rejection of form to all pending claims 1-18, provided substantive rejections of claims 1-6, 10-13 and 16-18, and objected to claims 7-9, 14 and 15.

The Applicant has hereinabove presented amendments to the abstract, specification and claims. The abstract has been amended to better set forth a description of the disclosure. Support for language provided in the amended abstract include in the specification at page 5, line 16 to page 6, line 4.

The title of the specification has been amended to better conform to the claimed subject matter. An amendment has been provided to the specification at page 4 to identify the disclosed circuit board and circuit portion as a "circuit assembly" to enhance readability and consistency of the specification and claims.

Claims 1-2, 4, 7-10, 12 and 16 have been amended, claims 17-18 have been cancelled without prejudice, and new claims 19-21 have been added. These amendments include amendments to independent claim 1 to now generally feature "a circuit assembly supported by the actuator block; and a damping assembly interfaced between the actuator block and the circuit assembly." Support for this includes FIG. 4 and in the specification at page 5, line 16 to page 6, line 4, as well as in the newly amended text of the specification at page 4.

Similar amendments have been provided to independent claims 10 and 16. The various dependent claims have been amended to better conform to the amended independent claims.

These amendments are proper, do not introduce new matter, serve to clarify without narrowing the scope of the claimed subject matter, are not provided for reasons substantially

relating to patentability, and serve to place the application in proper condition for reconsideration and allowance.

Objection to the Abstract

The first Office Action objected to the abstract due to insufficient length. The Applicant has hereinabove amended the abstract accordingly, and requests reconsideration and withdrawal of this objection in view thereof.

Rejection of Claims Under 35 U.S.C. §112

Claims 1-18 were rejected under §112, second paragraph as being indefinite for the use of the term "portion." The Applicant has amended the claims and the specification to use the phrase "circuit assembly," and it is believed that this new language should obviate the rejection under §112, second paragraph.

Rejection of Claims Under 35 U.S.C. §103(a)

Claims 1-2, 5-6, 10, 13 and 16 were rejected as being obvious over U.S. Patent No. 6,879,466 to Oveyssi et al. ("Oveyssi '466") in view of U.S. Patent No. 6,175,469 to Ahmad et al. ("Ahmad '469"). Claims 3-4, 11-12 and 17-18 were further rejected as being obvious over the foregoing references, further in view of U.S. Published Patent Application No. US2003/0169537 to Weichelt et al. ("Weichelt '537). These rejections are respectfully traversed.

Initially, the Applicant notes that Weichelt '537 is only available as prior art under §102(e). Accordingly, pursuant to §103(c), Weichelt '537 is not available for consideration as a reference under §103(a) to the claims of the present application.

With regard to the rejection of claim 1, the Applicant agrees that Oveyssi '466 is at least deficient with regard to teaching or suggesting "a damping assembly interfaced between the actuator block and the circuit assembly." However, the Applicant respectfully submits that Ahmad '469 fails to make up for the deficiencies of Oveyssi '466.

In order to establish a *prima facie* case of obviousness, all of the limitations must be shown as being taught or suggested by the references, and this has not been established by the combination of Oveyssi '466 and Ahmad '469. Oveyssi '466 teaches a circuit assembly (not numerically denoted) mounted to a side of the actuator 30, and expressly teaches to place the damper 62 on a second side of the actuator 30 opposite the circuit assembly (see e.g., FIG. 1).

Ahmad '469 does not teach to place a damper on an actuator assembly, or even to couple the damper to a circuit assembly, but instead places a damper 154 between a stationary VCM magnetic pole piece 134 and a top cover 140 of the device 100, which brings one skilled in the art no closer to the claimed invention.

Indeed, the Applicant respectfully submits that one skilled in the art would view Oveyssi '466 as teaching away from placement of the damper 62 between the circuit assembly and the actuator 30, including on the basis that the damper 62 includes projections that extend along the edges of the arms (see e.g., FIG. 2 of Oveyssi '466), and such arms would interfere with the routing of the conductive paths from the circuit assembly to the heads 42, 44. It is believed that this is one reason why Oveyssi '466 specifically teaches to place the damper 62 on the "free" side opposite the circuit assembly.

Moreover, the Applicant notes that the damper 62 taught by Oveyssi '466 serves to dampen vibration modes of the actuator arms 34 and the coil support 50, by providing constrain layer damping in a plane orthogonal to the butterfly motion of these members. See e.g., col. 4, lines 14-33. By contrast, interposing the damper between the actuator block and the circuit assembly, as set forth by claim 1, serves to provide localized mass and rigidity proximate the circuit board, and to isolate (decouple) the circuit assembly from the actuator block. This is a problem not addressed or even considered by Oveyssi '466.

Accordingly, the Applicant respectfully submits that the rejection is based on improper hindsight reconstruction of the claims, and is therefore improper. Reconsideration and withdrawal of the rejection of claim 1, and for the claims depending therefrom, are thus respectfully requested.

As Oveyssi '466 and Ahmad '469 are similarly deficient with respect to the subject matter of independent claims 10 and 16, reconsideration and withdrawal of the rejection of these claims, as well as for the claims depending therefrom, are also respectfully requested.

Finally, as Weichelt '537 is not available as a reference under §103(a), reconsideration and withdrawal of the rejections of claims 3-4, 11-12 and 17-18 are additionally requested on this basis as well.

Allowable Subject Matter

The Applicant gratefully acknowledges the indication of allowability of dependent claims 7-9, 14 and 15.

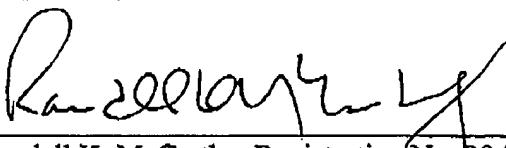
Newly Added Claims 19-21

Pursuant to 37 CFR 1.111, newly added claims 19-21 depend from independent claim 16, and are therefore believed to be patentable as depending from a patentable base claim. Support for newly added claims 19-21 are respectively provided including by the language of dependent claims 3, 4, and 7.

Conclusion

This is intended to be a complete response to the first Office Action mailed September 1, 2005. Reconsideration and allowance of all of the pending claims are respectfully requested. Should any questions arise concerning this response, the Examiner is invited to contact the below signed Attorney.

Respectfully Submitted,

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